

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Dan Kikinis

Serial No.: 09/875,546

Filed: June 5, 2001

For: Remote Control of Program Scheduling

Atty. Docket No.: 007287.00046

Group Art Unit: 2421

Examiner: Salce, Jason P.

Confirmation No.: 6897

APPEAL BRIEF

U.S. Patent and Trademark Office
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Sir:

This is an Appeal Brief filed in support of Appellant's June 2, 2009, Notice of Appeal. Appeal is taken from the Final Office Action mailed January 2, 2009.

General Authorization of Payment of Fees

If any fees are due in this application, whether or not associated with this filing, please charge any fees due to Deposit Account No. 19-0733. Any necessary extensions of time are hereby requested.

REAL PARTY IN INTEREST

37 C.F.R. § 41.37(c)(1)(i)

The owner of this application, and the real party in interest, is JLB Ventures LLC.

RELATED APPEALS AND INTERFERENCES

37 C.F.R. § 41.37(c)(1)(ii)

There are no related appeals or interferences.

STATUS OF CLAIMS

37 C.F.R. § 41.37(c)(1)(iii)

Claims 1, 5-6, 9, 13-14, 17, 21-22 and 25-39 are rejected and presently appealed.

Claims 2-4, 7-8, 10-12, 15-16, 18-20 and 23-24 have been canceled.

STATUS OF AMENDMENTS

37 C.F.R. § 41.37(c)(1)(iv)

No amendments have been made subsequent to final rejection.

SUMMARY OF CLAIMED SUBJECT MATTER

37 C.F.R. § 41.37(c)(1)(v)

In making reference herein to various embodiments in the specification text and/or drawings to explain the claimed invention, Appellant does not intend to limit the claims to those embodiments; all references to the filed specification and drawings are illustrative unless otherwise explicitly stated. Moreover, written description support may be found in the filed specification when read as a whole, in addition to the specific passages cited.

Independent claim 1 is directed to a system comprising a video display configured to communicate with a receiving system and to display a video broadcast. *Specification*, p. 7, ¶ 20; Fig. 1 (105). The system further comprises a computing device configured to communicate with the receiving system, the computing device having a second display configured to concurrently display an Electronic Programming Guide (EPG) corresponding to the video broadcast. *Id.*, p. 4, ¶ 8; pp.8-9, ¶¶ 25-26; Fig. 1 (150). The system further comprises wherein the computing device is configured to display at least a portion of the EPG on the second display while the video display is concurrently displaying at least a portion of the EPG. *Id.*, pp. 10-11, ¶ 33.

Independent claim 9 is directed to a method comprising receiving, at a computing device in communication with a first video display, program listing data associated with a video broadcast being displayed on the first video display, the computing device having a second display. *Specification*, pp. 8-9, ¶¶ 25-26; Fig. 1 (154). The method further comprises displaying on the second display an Electronic Programming Guide (EPG) based on the received program listing data and corresponding to the video broadcast being displaying on the first video display. *Id.*, p. 9, ¶ 29. The method further comprises receiving user input at the computing device corresponding to a request to display at least a portion of the EPG on the first video display while concurrently displaying at least a portion of the EPG on the second display. *Id.*, p. 10, ¶ 33. The method further comprises causing at least a portion of the EPG to be displayed on the first video display while concurrently displaying a portion of the EPG on the second display. *Id.*, p. 10, ¶ 33.

Independent claim 17 is directed to machine readable medium having stored thereon a set of instructions, which when executed cause a computing device to perform a method. *Specification*, p. 12, ¶ 39. The method comprises receiving program listing data associated with a video broadcast being displaying on a first video display. *Specification*, pp. 8-9, ¶¶ 25-26; Fig. 1 (154). The method further comprises displaying on a second display an Electronic Programming Guide (EPG) based on the received program listing data and corresponding to the video broadcast being displaying on the first video display. *Id.*, p. 9, ¶ 29. The method further comprises receiving user input corresponding to a request to display at least a portion of the EPG on the first video display while concurrently displaying at least a portion of the EPG on the second display. *Id.*, p. 10, ¶ 33. The method further comprises causing at least a portion of the EPG to be displayed on the first video display while concurrently displaying a portion of the EPG on the second display. *Id.*, p. 10, ¶ 33.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

37 C.F.R. § 41.37(c)(1)(vi)

- Claims 1, 5, 6, 9, 13-14, 17, 21-22 and 25-39 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.
- Claims 1, 9, 12, 15, 17, 20, 23 and 25-39 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,862,741 to Grooters (“Grooters”).

- Claims 5-6, 13-14 and 21-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Grooters, in view of U.S. Patent No. 6,774,926 to Ellis *et al.* (“Ellis”).

ARGUMENT

37 C.F.R. § 41.37(c)(1)(vii)

A. Rejection of Claims 1, 5, 6, 9, 13, 14, 17, 21, 22, and 25-39 as failing to comply with the written description requirement

The claims presently appealed relate to displaying at least a portion of an electronic programming guide (EPG) on a first video display while concurrently displaying at least a portion of the EPG on a second video display.

Independent claim 1 recites, among other features “wherein the computing device is configured to display at least a portion of the EPG on the second display while the video display is concurrently displaying at least a portion of the EPG.” The Office Action alleges that this claimed feature is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time of the application was filed, had possession of the claimed invention.¹

Specifically, the Office Action argues the following:

There is no positive recitation that while an EPG is displayed on the computer device 105, the EPG may also be displayed on video display 105 concurrently. The specification only teaches that portions of an EPG can be displayed on either device.

Id.

Appellant disagrees with the position taken by the Office. For example, claim 2 of the instant application as originally filed states:

2. The system of claim 1, wherein the video display can display a portion of the EPG concurrently displayed on the second display of the computing device.

Specification, p 13. Original claims 10 and 17 recite features similar to original claim 2.

¹ Final Office Action dated Jan. 2, 2009, p. 4.

Furthermore, the original specification describes that “[a] user of the EPG displayed on computing device 105 may also, though input device 160, **display portions** of or the entire EPG on video display 105...allow[ing] those who have poor vision, or are otherwise unable to use display screen 158, to use the EPG.” (emphasis added). *Specification*, p. 10, ¶ 33. Appellant notes a typographic error in this section; the reference element for the computing device should be “150,” not “105.” This usage is consistent with all remaining portions of the specification. Furthermore, even without this correction, paragraph [0033] of the specification clearly describes the same EPG displayed on both video display 105 and on the separate display screen 158.

Applicant’s possession of the claimed invention with respect to the feature, “wherein the computing device is configured to display at least a portion of the EPG on the second display while the video display is concurrently displaying at least a portion of the EPG,” is further evidenced by U.S. Provisional Appl. No. 60/215,681, the provisional application corresponding to the instant application. For example, page 3, lines 22-26 and Fig. 1 of the provisional application describes sharing EPG information on multiple displays in a similar manner to paragraph [0033] of the instant specification.

Appellant maintains that these disclosures, along with the additional support found throughout the specification, clearly convey that the inventor had possession of the claimed invention at the time the application was filed.

Furthermore, regarding the support in claim 2 of the original application, both the Final Office Action and the Advisory Action of May 12, 2009, merely argue that the wording of original claims 2 differs from the wording of current claim 1:

For example, original claim 1 states “**a computing device coupled with**”, as opposed to the currently claimed “**a computing device configured to**”. Further, original claim 2 states, “**wherein the video display can display a portion of the EPG concurrently displayed on the second display of the computing device**”, while the currently presented claim state, “**wherein the computing device is configured to display at least a portion of the EPG on the second display while the video display is concurrently displaying at least a portion of the EPG.**”

Advisory Action of May 12, 2009, p. 2 (emphasis in Advisory Action). Based on these differences, the Examiner concludes:

As shown, both claims differ
in scope and therefore the original disclosure of the specification cannot be used to
support the currently amended claims.

Id. Appellant does not believe the Examiner's argument is proper with respect to the written description requirement. To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. MPEP § 2163 (I). There is no requirement, as suggested by the Final Office Action and the Advisory Action, that the wording of the original disclosure must exactly match the current claim scope. Original claim 2 clearly discloses displaying a portion of an EPG on a first video display while concurrently displaying the EPG a second display. Based on this section, and the additional support found throughout the specification, Appellant submits that one skilled in the art would reasonably conclude that the inventor had possession of the invention of current claims 1, 9, and 17. Accordingly, these rejections under 35 U.S.C. § 112, first paragraph, should be reversed.

The Final Office Action and Advisory Action further rejects claims 34 and 37 under 35 U.S.C. § 112, first paragraph, as allegedly failing to provide support in the original specification for displaying the same portion of the EPG on the different displays. (Emphasis added) Appellant respectfully disagrees. These claims are supported, for example, in paragraph [0033] of the specification as originally filed (see, *e.g.*, U.S. Provisional Appl. No. 60/215,681, page 3, ll. 22-26). These paragraphs describes, *inter alia*, that a user of the EPG displayed on computing device may interact with a user input device to “display portions of or the entire EPG on video display 105” so that it is possible for a user to “share programming information with all viewers,” including those “unable to use display screen 158.” Appellant submits that one skilled in the art would reasonably understand that sharing programming information with other viewers via a second display screen involves displaying the same portion of the EPG on the two different displays. Therefore, Appellant also requests reconsideration and reversal of the pending rejections of claims 34 and 37 under 35 U.S.C. § 112, first paragraph.

Claims 5, 6, 13, 14, 21, 22, 25-33, 35-36 and 38-39 are dependent on independent claims 1, 9, and 17 and enabled for at least the same reasons discussed above. Appellant respectfully requests reconsideration and reversal of this rejection.

B. Rejection of Claims 1, 9, 17 and 25-39 as anticipated by Grooters

1. Independent Claims 1, 9, and 17

Independent claim 1 recites, among other features, “wherein the computing device is configured to display at least a portion of the EPG on the second display while the video display is concurrently displaying at least a portion of the EPG.” In the Final Office Action of January 2, 2009, the Office alleges that Grooters teaches the second display concurrently displaying at least a portion of the EPG at column 7, lines 24-36. However, col. 7, lines 24-36 of Grooters only states that after the user selects an option from an EPG on the first display 226, the program guide data is displayed on the second display 228, rather than on display 226. Furthermore, neither this section nor any other section of Grooters uses the word “concurrently” or any equivalent term. Thus, Appellant submits that Grooters does not disclose portions of an EPG displayed “concurrently” on two different displays. In fact, if anything, Grooters indicates that the EPG would be displayed on one device or the other, but not concurrently on both devices.

Additionally, Appellant notes that claim 1 of Grooters was also relied upon by the Final Office Action in this rejection. However, neither this language nor any similar language existed in Grooters at the time the application was filed. Therefore, the language of claim 1 of Grooters is not prior art to the present application.

Therefore, since Grooters does not disclose “display[ing] at least a portion of the EPG on the second display while the video display is concurrently displaying at least a portion of the EPG,” claim 1 is not anticipated by Grooters.

Independent claims 9 and 17 each recite, “causing at least a portion of the EPG to be displayed on the first video display while concurrently displaying at least a portion of the EPG on the second display.” Therefore, for similar reasons to those discussed above in reference to claim 1, Grooters also does not anticipate claims 9 or 17.

2. Claims 25-27

Claims 25-27 depend respectively from claims 1, 9, and 17, and therefore are not anticipated by Grooters for at least the same reasons discussed above.

Furthermore, claims 25-27 each recite displaying the entire EPG on the video display concurrently while displaying the entire EPG on the second display. As discussed above, Grooters does not disclose concurrently displaying an EPG on multiple displays. Furthermore, even assuming, without admitting, that Grooters did teach concurrently displaying the EPG on multiple displays, it would still only teach a portion of the EPG on each display. As discussed above, col. 7, lines 24-36 of Grooters only teaches displaying the EPG on first display 226 in “a minimally invasive or interfering manner” which in fact teaches away from displaying the entire EPG on the video display. Appellant submits that displaying the entire EPG on a first display would not be displaying the EPG in a minimally invasive manner. Thus, claims 25-27 are also not anticipated by Grooters for at least this additional reason.

3. Claims 28-30

Claims 28-30 depend respectively from claims 1, 9, and 17, and therefore are not anticipated by Grooters for at least the same reasons discussed above.

Furthermore, claims 28-30 each recite transmitting a signal to a receiving system to display at least a portion of the EPG on the video display concurrently while displaying at least a portion of the EPG on the second display. The Final Office Action alleges that Grooters teaches this additional feature somewhere between col. 5, line 43 and col. 8, line 20.² Initially, Appellant notes that the portion of Grooters relied upon by the Examiner as allegedly teaching this feature constitutes the bulk of the Grooters disclosure, and the Office has not identified with specificity where in Grooters the alleged teaching is to be found. Additionally, as discussed above, Appellant has carefully reviewed the entirety of the Grooters reference and finds no teaching of “transmit[ting] a signal to [a] receiving system ... to display at least a portion of the EPG on the video display concurrently while displaying at least a portion of the EPG on the second display.” Thus, for at least this additional reason, Grooters cannot anticipate claims 28-30.

4. Claims 31-33

Claims 31-33 depend respectively from claims 1, 9, and 17, and therefore are not anticipated by Grooters for at least the same reasons discussed above.

² *Id.*

Furthermore, claims 31-33 each recite displaying “less than the entire EPG” on the video display concurrently while displaying at least a portion of the EPG on the second display. The Final Office Action alleges that Grooters teaches this additional feature somewhere between col. 5, line 43 and col. 8, line 20.³ Initially, Appellant notes that the portion of Grooters relied upon by the Examiner as allegedly teaching this feature constitutes the bulk of the Grooters disclosure, and the Office has not identified with specificity where in Grooters the alleged teaching is to be found. Additionally, Appellant has carefully reviewed the entirety of the Grooters reference and finds no teaching of recite displaying “less than the entire EPG” on the video display concurrently while displaying at least a portion of the EPG on the second display. Thus, for at least this additional reason, Grooters cannot anticipate claims 31-33.

5. Claims 34 and 37

Claims 34 and 37 depend respectively from claims 1 and 9, and therefore are not anticipated by Grooters for at least the same reasons discussed above.

Furthermore, claims 34 and 37 recite wherein the portion of the EPG displayed on the first video display is the same as the portion of the EPG concurrently displayed on the second display. As discussed above, Grooters does not disclose displaying portions of an EPG concurrently on two different displays. Furthermore, even assuming, without admitting, that Grooters did teach concurrently displaying the EPG on multiple displays, it still would not teach the additional feature of displaying the same portion of the EPG on both displays, as recited in claims 34 and 37. Thus, for at least this additional reason, Grooters cannot anticipate claims 34 and 37.

6. Claims 35, 36, 38, and 39

Claims 35, 36, 38, and 39 each depend from claims 1 or claim 9, and therefore are not anticipated by Grooters for at least the same reasons discussed above.

Furthermore, claims 35 and 38 recite displaying a “preview of a broadcast program” on the second display, while claims 36 and 39 further recite wherein the preview of the broadcast program is displayed on the second display concurrently while a separate broadcast program is

³ *Id.*

displayed on the first video display. The Office Action alleges that Grooters teaches displaying a preview at col. 7, lines 24-35.⁴ However, the Appellant disagrees with the Office's characterization of a preview as merely "the time and information related to the highlighted time slot." The word "preview" as defined by Dictionary.com means "an advance showing of brief scenes in a motion picture, television show, etc., for purposes of advertisement."⁵ The definition of preview provided by the Office Action not only makes these claims redundant, it is also contrary to what one of ordinary skill in the art would understand as a "preview of a broadcast program." Therefore, since Grooters does not disclose or even suggest displaying a preview of a broadcast program on the second display, claims 35, 36, 38, and 39 are also not anticipated for at least this additional reason.

C. Rejection of Claims 5-6, 13-14 and 21-22 over Grooters, in view Ellis

Claims 5-6, 13-14 and 21-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Grooters in view of Ellis. However, Ellis fails to overcome the above-discussed deficiencies of Grooters, in that Ellis also fails to disclose or suggest "display[ing] at least a portion of the EPG on the video display while concurrently displaying at least a portion of the EPG on the second display," as recited in claim 1, or "causing at least a portion of the EPG to be displayed on the first video display while concurrently displaying at least a portion of the EPG on the second display," as recited in claim 9 and 17. Accordingly, dependent claims 5-6, 13-14 and 21-22 are not obvious in view of the purported combination of Grooters and Ellis for at least the same reasons as their respective base claims, as well as based on the additional features recited therein.

⁴ *Id.* at 8.

⁵ Retrieved on March 30, 2009, from <http://dictionary.reference.com/browse/preview>.

CONCLUSION

For all of the foregoing reasons, Appellant respectfully submits that the final rejection of claims 1, 5, 6, 9, 13, 14, 17, 21, 22 and 25-39 is improper and should be reversed.

Respectfully submitted,
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CLAIMS APPENDIX
37 C.F.R. § 41.37(c)(1)(viii)

Claims involved in the appeal:

Claim 1: A system comprising:

a video display configured to communicate with a receiving system and to display a video broadcast; and

a computing device configured to communicate with the receiving system, the computing device having a second display configured to concurrently display an Electronic Programming Guide (EPG) corresponding to the video broadcast,

wherein the computing device is configured to display at least a portion of the EPG on the second display while the video display is concurrently displaying at least a portion of the EPG.

Claim 5: The system of claim 1, wherein the computing device is a Personal Digital Assistant (PDA).

Claim 6: The system of claim 1, wherein the computing device is a Web Phone.

Claim 9: A method comprising:

receiving, at a computing device in communication with a first video display, program listing data associated with a video broadcast being displayed on the first video display, the computing device having a second display;

displaying on the second display an Electronic Programming Guide (EPG) based on the received program listing data and corresponding to the video broadcast being displaying on the first video display;

receiving user input at the computing device corresponding to a request to display at least a portion of the EPG on the first video display while concurrently displaying at least a portion of the EPG on the second display; and

causing at least a portion of the EPG to be displayed on the first video display while concurrently displaying at least a portion of the EPG on the second display.

Claim 13: The method of claim 9, wherein the computing device is a Personal Digital Assistant (PDA).

Claim 14: The method of claim 9, wherein the computing device is a Web Phone.

Claim 17: A machine readable medium having stored thereon a set of instructions, which when executed cause a computing device to perform a method comprising:

- receiving program listing data associated with a video broadcast being displaying on a first video display;

- displaying on a second display an Electronic Programming Guide (EPG) based on the received program listing data and corresponding to the video broadcast being displaying on the first video display;

- receiving user input corresponding to a request to display at least a portion of the EPG on the first video display while concurrently displaying at least a portion of the EPG on the second display; and

- causing at least a portion of the EPG to be displayed on the first video display while concurrently displaying at least a portion of the EPG on the second display.

Claim 21: The machine readable medium of claim 17, wherein the computing device is a Personal Digital Assistant (PDA).

Claim 22: The machine readable medium of claim 17, wherein the computing device is a Web Phone.

Claim 25: The system of claim 1, wherein the computing device and the video display are configured such that the entire EPG is displayed on the video display concurrently while the entire EPG is displayed on the second display.

Claim 26: The method of claim 9, further comprising displaying the entire EPG on the video display concurrently while displaying the entire EPG on the second display.

Claim 27: The machine readable medium of claim 17, the method further comprising displaying the entire EPG on the video display concurrently while displaying the entire EPG on the second display.

Claim 28: The system of claim 1, wherein the computing device is configured to transmit a signal to the receiving system corresponding to an instruction to display at least a portion of the EPG on the video display concurrently while at least a portion of the EPG is displayed on the second display.

Claim 29: The method of claim 9, further comprising transmitting a signal to a receiving system connected to the video display, the signal corresponding to an instruction to display at least a portion of the EPG on the video display concurrently while displaying at least a portion of the EPG on the second display.

Claim 30: The machine readable medium of claim 17, the method further comprising transmitting a signal to a receiving system connected to the video display, the signal corresponding to an instruction to display at least a portion of the EPG on the video display concurrently while displaying at least a portion of the EPG on the second display.

Claim 31: The system of claim 1, wherein the computing device and the video display are configured such that less than the entire EPG is displayed on the video display concurrently while at least a portion of the EPG is displayed on the second display.

Claim 32: The method of claim 9, further comprising displaying less than the entire EPG on the video display concurrently while displaying at least a portion of the EPG on the second display.

Claim 33: The machine readable medium of claim 17, the method further comprising displaying less than the entire EPG on the video display concurrently while displaying at least a portion of the EPG on the second display.

Claim 34: The system of claim 1, wherein the computing device and the video display are configured such that the portion of the EPG displayed on the computing device is the same as the portion of the EPG concurrently displayed on the video display.

Claim 35: The system of claim 1, wherein the computing device is further configured to display a preview of a broadcast program displayed in the EPG.

Claim 36: The system of claim 35, wherein the computing device and the video display are configured such that the preview of the broadcast program is displayed on the computing device concurrently while a separate broadcast program is displayed on the video display.

Claim 37: The method of claim 9, wherein the portion of the EPG displayed on the first video display is the same as the portion of the EPG concurrently displayed on the second display.

Claim 38: The method of claim 9, further comprising displaying on the second display a preview of a broadcast program displayed in the EPG.

Claim 39: The method of claim 38, wherein the preview of the broadcast program is displayed on the second display concurrently while a separate broadcast program is displayed on the first video display.

EVIDENCE APPENDIX
37 C.F.R. § 41.37(c)(1)(ix)

NONE.

RELATED PROCEEDINGS APPENDIX
37 C.F.R. § 41.37(c)(1)(x)

NONE.